

Application No. 09/935,337  
Amendment Dated May 21, 2003  
Reply to Office Communication of April 28, 2003

**REMARKS/ARGUMENTS:**

This Response responds to the Office Communication dated April 28, 2003. Three restrictions are made in the Office Communication. First, the Examiner has required an election of species between Species A for electrofusion joint forming apparatus and method with a heating element secured via a fastener (claims 1-13 and 17-58) and Species B for electrofusion joint forming apparatus and method with a heating element secured without a fastener (claims 14-16 and claims 59-72). Second, the Examiner has required an election of subspecies between Subspecies 1 for electrofusion apparatus and method for two pipes fused together without a fitting and Subspecies 2 for electrofusion apparatus and method for two pipes fused together with a fitting. Third, if Species B is elected, the Examiner has required a further election of inventions between Invention I for an electrofusion weld joint forming heating element (claims 14-16) and Invention II for an apparatus and method of forming an electrofusion pipe joint without a fastener (claims 59-72).

In response to the restriction requirements, an election of Species A and Subspecies 1 is made with traverse. The claims corresponding to elected Species A and Subspecies 1 are claims 1 – 10, 17 – 34 and 45 – 51, which are disclosed in FIGS. 1 – 10 and FIGS. 15 – 18C. The restriction requirements are traversed for the reasons set forth below. Reconsideration of the species, subspecies and invention restriction requirements is requested.

The Examiner further restricts both Species A and Species B to Subspecies 1 for electrofusion apparatus and method where two pipes are fused together without a fitting and a heating element is embedded in pipe and Subspecies 2 for electrofusion apparatus and method where two pipes are fused together with a fitting and a heating element is embedded in the fitting between the pipes. As noted above, Applicant elects Subspecies 1 with traverse. Applicant submits that Subspecies 1 and Subspecies 2 claims are sufficiently related and that they should be examined together.

Applicant notes that “[i]f the search and examination of an entire application can be made *without* serious burden, the Examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.” MPEP § 803 (emphasis added).

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Furthermore, MPEP § 803 also states that “Examiners must provide reasons and/or examples to support conclusions”. On page 3 of the Office Communication, it is stated that the inventions “have acquired a separate status in the art as shown by their different classification and divergent subject matter”. However, no differing classifications are cited to support the conclusion that Subspecies 1 and Subspecies 2 are classified differently. Moreover, both Subspecies relate to embedding a heating element in a meltable member, so that there is no divergent subject matter.

Furthermore, independent claim 1 broadly recites a heating element embedded in a meltable member for creating an electrofusion joint, which is readable on both Subspecies 1 for one pipe having an embedded heating element for joining two pipes together and Subspecies 2 for a fitting having an embedded heating element for joining two pipes together. Since claim 1 is generic with regard to Subspecies 1 and 2, the restriction requirement is improper.

Additionally, Applicant is entitled to a reasonable number of species and should not be restricted to a single disclosed species. MPEP § 806.04(a). The number of subspecies recited in the claims does not require a burdensome search to properly examine the claims together. As noted above, examination of claim 1 that broadly recites a heating element embedded in a meltable member would not create a serious burden on the Examiner for examination of Subspecies 1 and 2 together.

Therefore, Applicant submits that the improper restriction to the specific subspecies be withdrawn.

Applicant further submits that the Species A and Species B claims are sufficiently related and should also be examined together. Independent claim 64 of Species B is broadly directed to an electrofusion pipe joint having first and second members, and a heating element embedded in one of the first and second members. Independent claim 1 of Species A is broadly directed to an assembly for making an electrofusion joint in which a heating element is secured to a meltable member by a fastener. As noted above, “[i]f the search and examination of an entire application can be made *without* serious burden, the Examiner *must*

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examine it on the merits, even though it includes claims to independent or distinct inventions.” MPEP § 803 (emphasis added). Examining a heating element secured in a meltable member by a fastener would not impose an extra burden on the Examiner in addition to examining a heating element secured in a meltable member without a fastener. Thus, examining Species A and B together would not impose a serious burden on the Examiner.

Moreover, MPEP § 803 states that “Examiners must provide reasons and/or examples to support conclusions”. On page 3 of the Office Communication, it is stated that the inventions “have acquired a separate status in the art as shown by their different classification and divergent subject matter”. However, no differing classifications are cited to support the conclusion that Species A and Species B are classified differently. Furthermore, since both Species A and Species B broadly cover use of a heating element in a meltable member for creating an electrofusion joint, there is no divergent subject matter.

Therefore, Applicant requests that the improper restriction requirement between Species A and Species B be withdrawn.

The Examiner further restricts Species B to Invention I for a heating element and Invention II for an electrofusion joint using a heating element. Applicant submits that the claims of Invention I and Invention II are sufficiently related and should be examined together.

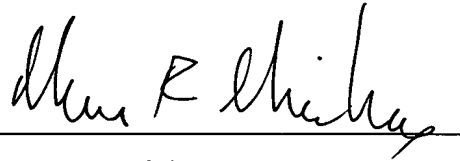
As noted above, MPEP § 803 states that “[i]f the search and examination of an entire application can be made *without* serious burden, the Examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions.” (emphasis added). Examination of Invention I and Invention II would not impose a serious burden on the Examiner since Invention I is for a heating element and Invention II is for an electrofusion joint using a heating element, which are sufficiently related inventions.

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In view of the foregoing comments, Applicant respectfully requests reconsideration of the restriction requirement and examination of all claims on the merits. Prompt and favorable action is solicited.

Respectfully Submitted,

A handwritten signature in dark ink, appearing to read "Marcus R. Mickney", is written over a horizontal line.

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